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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Rudolf Berger

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1788

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BOYLE FREDRICKSON S.C.
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EXAMINER

SMITH, SCOTT A

ART UNIT

PAPER NUMBER

3721

NOTIFICATION DATE

DELIVERY MODE

06/18/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

DETAILED ACTION

The amendment filed on 3/14/08 has been entered and the remarks therein have been considered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 8, 11, 12 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by German Patent Application DE 101 58 266 A1, hereinafter Bosch '266.

Bosch '266 discloses a hand held tool comprising a first unit 2, a second unit 3, a vibration isolating device 5, 11 between the units and having an actuator 5 for producing an actuating force in a working direction which can be actuated via a pneumatic drive, which is deemed to inherently constitute a handle air spring (note: Fig. 2), the tool further comprising a spring device 4 which is parallel to the actuator, a sensor 14, 15 for determining the spacing of the units, wherein the tool is presumed to function without the spring device "bottoming out", as per claim 11, and to cyclically function, as per claim 12 due to the sensor 14, 15 and associated controller 7.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 2, 8, 10-13, 15 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Application DE 101 58 266 A1, hereinafter Bosch '266.

In the event that Bosch '266 is interpreted not to include the actuator having an air spring as claimed, applicant is given Official Notice that to dampen vibrations in tool handles via air springs is well known, as well as providing damping devices with air springs that are pneumatically adjustable. Therefore, it would have been obvious to one skilled in the art to form the actuator of Bosch '266 as claimed in order to allow for dynamic damping during use. Regarding claims 10, 13, and 15, Bosch '266 is silent as the functional parameters. In any event, it would have been obvious to one skilled to allow for the specifically claimed operating parameters since to do so provides no new and unexpected results and is within the engineering purview of the skilled artisan.

Response to Arguments

6. Applicant's arguments filed on 3/14/08 have been fully considered but they are not persuasive. Applicant argues that Bosch fails to disclose the invention as claimed

including a handle air spring which is part of an actuator, and being able to be modify the compressed air within the handle air spring. The Examiner disagrees. The actuator 5 is air actuated and controller 7 varies the air volume therein. The actuator inherently dampens handle vibrations due to its orientation, and thus constitutes an air spring. Applicant argues that Bosch teaches away since the actuator 5 is coaxial with the spring 4, and is thus not parallel. It is the Examiner's position that coaxial elements are also parallel, and thus discloses the invention as claimed.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Smith whose telephone number is 571-272-4469. The examiner can normally be reached on 5:30-4:00 Tues.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Smith

/Scott A. Smith/
Primary Examiner, Art Unit 3721